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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,957	06/20/2003	Garth Powis	126387.530	6628

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EXAMINER

FETTEROLF, BRANDON J

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/600,957

Applicant(s)

POWIS, GARTH

Examiner

Brandon J. Fetterolf, PhD

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, as specifically drawn to a method of inhibiting tumor cell growth in a tumor cell that over-expresses thioredoxin comprising contacting a tumor cell with a cell growth inhibiting effective amount of an inhibitor of thioredoxin expression, classified in class 424, subclass 130.1.
- II. Claims 3-5, as specifically drawn to a method of identifying an agent that inhibits tumor cell growth or reduces inhibition of apoptosis that over express thioredoxin, classified in class 435, subclass 6, 7.1.
- III. Claim 6, as specifically drawn to a method of stimulating cell growth comprising introducing a nucleic acid encoding a human thioredoxin having Ser at amino acid residue 73 under conditions whereby said nucleic acid is expressed, classified in class 514, subclass 44.
- IV. Claims 7-8, as specifically drawn to a composition comprising an agent that is useful in reducing or eliminating thioredoxin-associated apoptosis inhibition and an acceptable carrier, classified in class 530, subclass 387.1.

Groups I and IV contain subject matter directed to patentably distinct inventions, NOT species: each of the specifically claimed agents recited in the specification (page 6), e.g., antisense, antibodies, or small organic compound, lack unity of invention because the agents have no substantial structural similarities although they have a common utility, i.e. inhibition of cell growth or inhibiting reduced apoptosis. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300(CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed invention for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the invention that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the specification does not disclose that their methods would be used together. The method of inhibiting tumor cell growth and/or reduces inhibition of apoptosis in a tumor cell that over-expresses thioredoxin (Group I), a method of identifying an agent which inhibits cell growth and/or apoptosis (Group II) and a method of stimulating cell growth (Group III) are unrelated as they comprise distinct steps and utilize different products which demonstrates that each method has a different mode of operation. Each invention performs this function using structurally and functionally divergent material. Moreover, the methodology and materials necessary for inhibition of cell growth and/or apoptosis and stimulation of cell growth differ significantly for each of the materials. For inhibiting apoptosis and/or cell growth, an antibody, antisense or small organic compound may be used (specification, page 6). For stimulating cell growth, a nucleic acid encoding a human thioredoxin having Ser at amino acid residue 73 may be introduced under conditions whereby said nucleic acid is expressed. For identifying an agent that inhibits cell growth or reduces inhibition of apoptosis, two different cell lines are used to measure the expression or activity of thioredoxin, wherein the second sample is contacted with an agent. Therefore, each method is divergent in materials and steps. For these reasons the inventions of Groups I-III are patentably distinct.

Furthermore, the distinct steps and material used require separate and distinct searches. The inventions of Groups I-III have a separate status in the art as shown by their different classifications. As such, it would be burdensome to search the inventions of Groups I-III.

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The inventions of Group IV and Groups I-II are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the composition as claimed can be used in a materially different process such as in the inhibition, in vitro or in vivo, of tumor growth or reducing inhibition of apoptosis or the composition can be used in a screening process.

Furthermore, searching the inventions of Group IV and Groups I-II would impose a serious search burden. The inventions have separate status in the art as shown by their different classifications. Moreover, a composition comprising an agent that is useful for inhibiting cell growth or reducing inhibition of apoptosis may be known even if the process of using said composition is novel. As such, it would be burdensome to search the inventions of Groups I-II and IV

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

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Note:

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04.

**Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J. Fetterolf, PhD whose telephone number is (571)-272-2919. The examiner can normally be reached on Monday through Friday from 7:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brandon J Fetterolf, PhD  
Patent Examiner  
Art Unit 1642

BF  
June 19, 2006

  
**JEFFREY SIEW**  
**SUPERVISORY PATENT EXAMINER**